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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEX P. JANSEN and STEPHEN GRIFFIN

Appeal 2009-012593
Application 10/063,125
Technology Center 3700

Before MICHAEL W. O'NEILL, STEFAN STAICOVICI, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Lex P. Jansen and Stephen Griffin (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's rejection of claims 1, 3, 6-8, 26-28, and 32-38. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

The Invention

The claimed invention is to a stent including an MRI and X-ray compatible stent material. Title and Spec. 2, para. [0005].

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. An expandable medical implant for implantation in a bodily vessel, the implant having a flow passage therethrough, the implant being in the form of a stent comprising a body having a generally tubular shape, the body capable of maintaining patency in a blood vessel, the body consisting essentially of an alloy comprising tungsten and rhenium, wherein the tungsten is present in an amount ranging from about 75 weight percent to about 99 weight percent.

The Prior Art

The Examiner relies upon the following as evidence of unpatentability:

| | | |
|-----------|--------------|---------------|
| Gianturco | US 4,800,882 | Jan. 31, 1989 |
| Mayer | US 5,630,840 | May 20, 1997 |
| Campbell | US 5,632,840 | May 27, 1997 |

The Rejections

The following Examiner's rejections are before us for review:

Claims 1, 3, 6-8, 26-28, and 32-38 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention. Ans. 3.

Claims 1, 3, 6-8, and 32-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gianturco and Mayer. Ans. 3-4.

Claims 26-28 and 36-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gianturco, Mayer, and Campbell. Ans. 4.

OPINION

35 U.S.C. § 112, second paragraph, rejection

For the reasons given by Appellants in the Reply Brief on page 1, line 20 through page 2, line 1, we conclude that the Examiner erred in rendering this rejection. As such, we reverse this rejection.

35 U.S.C. § 103(a) rejections

Appellants' arguments against these rejections appear predicated upon the position that the entire teachings of Mayer must be bodily incorporated into Gianturco in order to render the claimed subject matter as obvious, App. Br. 3-6, and that the Examiner has failed to set forth a *prima facie* case of obviousness and as such the Appellants are under no obligation to submit evidence of nonobviousness, Reply Br. 2.

"To justify combining reference teachings in support of a rejection it is not necessary that a device shown in one reference can be physically inserted into the device of the other. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (Internal citations omitted). *See also In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render obvious the

invention under review.”); and *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) (“Combining the teachings of references does not involve an ability to combine their specific structures.”). Moreover, an artisan must be presumed to know something about the art apart from what the references disclose, *see In re Jacoby*, 309 F.2d 513, 516 (CCPA 1962), the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment, *see Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889 (Fed. Cir. 1984), and skill is presumed on the part of those practicing in the art, *see In re Sovish*, 769 F.2d 738, 743 (Fed. Cir. 1985).

Here, as the Examiner has maintained, it is not necessary, nor has the Examiner asserted, that the proposed modification of Gianturco would have to include the casing as well as the core. Ans. 4 and 5. The Examiner’s rejection proposes to modify Gianturco with Mayer for increased radiopacity as taught by Mayer. *See Id.* and Mayer, col. 5, ll. 62-67. “[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007). In this case, according to Mayer, the technique to improve the radiopacity of stents is to fabricate them from an alloy of tungsten and rhenium. *See* Mayer, col. 5, ll. 62-67 and col. 11, ll. 55-58. Further, the Examiner’s proposed combination can assume “the inferences and creative steps that a person of ordinary skill in the art would employ,” such as mixing rhenium with tungsten to increase radiopacity. *KSR*, 550 U.S. at 418. After all, “[a]

person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.* at 421.

We find that the Examiner has set forth a *prima facie* case of obviousness in order to shift the burden to Appellants to present any evidence tending toward nonobviousness.

We have considered Appellants’ other arguments; however, we do not find any of them persuasive to demonstrate that the claimed invention would not have been obvious to a person of ordinary skill in the art at the time of the invention given the evidence and analysis set forth by the Examiner.

CONCLUSIONS

The Examiner’s rejection of claims 1, 3, 6-8, 26-28, and 32-38 under 35 U.S.C. § 112, second paragraph, is reversed.

The Examiner’s rejections of claims 1, 3, 6-8, 26-28, and 32-38 under 35 U.S.C. § 103(a) is sustained.

DECISION

The Examiner’s decision to reject claims 1, 3, 6-8, 26-28, and 32-38 as unpatentable is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

Klh